

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 30-55 are currently pending. Claims 30 and 55 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 30-55 were rejected under 35 U.S.C. § 112, second paragraph, regarding the inputting of opinion information into the inquiry input screen and the term “CAD”; Claims 30-33 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,999,908 to Abelow (hereinafter “the ‘908 patent”) in view of U.S. Patent No. 6,012,051 to Sammon, Jr. et al. (hereinafter “the ‘051 patent”); Claims 34,35,37, 39, and 43-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908 and ‘051 patents, further in view of U.S. Patent No. 6,578,014 to Murcko, Jr. (hereinafter “the ‘014 patent”); Claims 36, 38, and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908, ‘051, and ‘014 patents, further in view of the Palmer reference (“Fancy Labels, Plain Prices”); Claims 41 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908, ‘051, and ‘014 patents, further in view of U.S. Patent No. 6,012,045 to Barzalai (hereinafter “the ‘045 patent”); and Claims 51-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘908, ‘051, and ‘014 patents, further in view of Anonymous (“Fresh Cargo Brand is Renamed”).

Amended Claim 30 is directed to a merchandise planning and development method, comprising: (1) a merchandise planning information notice step of informing many and unspecified customers of merchandise planning and development information relating to design specifications of a trial product of new merchandise in a development period, through the Internet, and until before the trial product of the new merchandise is manufactured; (2) a

displaying step of displaying, on a display of a customer client, the merchandise planning and development information including a preview design of an image of the trial product received through the Internet; and (3) an inputting step of displaying an inquiry input screen on the display of the customer client after displaying the preview design of the image of the trial product for enabling the customers to input opinion information based on the displayed merchandise planning and development information in the development period of the new merchandise, prior to manufacture of the trial product of the new merchandise, not on actual use of the new merchandise by the customers, but on the merchandise planning and development information displayed on the display of the customer client, and for enabling the customers to send the opinion information, wherein, when the opinion information is input by the customers, the method further includes: (4) a receiving step of receiving, through the Internet, the opinion information input by the customers; (5) an opinion information collecting step of collecting the received opinion information input by the customers, through the Internet; (6) a drafting step of drafting an improved design of the trial product of the new merchandise using a computer-aided design CAD device, based on an improved design and specification of the trial product of the new merchandise determined according to an analysis of the opinion information collected; and (7) a merchandise information notice step of informing the customers of information on the improved design of the trial product of the new merchandise, through the Internet. The changes to Claim 30 are supported by the originally filed specification and do not add new matter.¹

Applicant respectfully submits that the rejections of the claims under 35 U.S.C. § 112, second paragraph, are rendered moot by the present amendment to Claims 30 and 55. Claims 30 and 55 have been amended to clarify that the term “CAD” refers to “computer-aided design.” Further, Claim 30 has been amended to recite an inputting step and to clarify that

¹ See, e.g., page 43, lines 2-10, and page 49, line 6, to page 52, line 6 in the specification.

when the opinion information is input by the customers, the method further includes a receiving step of receiving, through the Internet, the opinion information input by the customers. Accordingly, Applicant respectfully submits that there is antecedent basis for the term “the opinion information input by the customers.” Further, Applicants note that, for a method that is performed by a computer and requires input by a user, the steps that are actually performed by the computer are displaying an input screen and receiving the information input by the user. The computer does not do the inputting, the user does. Thus, a claim covering a process performed by a computer properly includes only those steps performed by the computer. Applicants respectfully submit that there is no requirement to the contrary under 35 U.S.C. §112. Accordingly, Applicant respectfully submits that the rejections of the claims under 35 U.S.C. § 112, second paragraph, are rendered moot by the present amendment to Claims 30 and 55.

Applicant respectfully submits that the rejection of Claim 30 under 35 U.S.C. § 103(a) is rendered moot by the present amendment to Claim 30.

Regarding the rejection of Claim 30 under 35 U.S.C. § 103(a), the Office Action asserts that the ‘908 patent discloses everything in Claim 30 with the exception of the transmission of data via the Internet, and relies on the ‘051 patent to remedy that deficiency.

Further, Applicant notes that pages 6 and 7 of the outstanding Office Action again assert that “... information describing the type of information displayed is considered to be nonfunctional descriptive material.”² Applicant strongly disagrees. In particular, Applicant notes that amended Claim 30 clearly states that the opinion information input by the customers is based on the **displayed** merchandise planning and development information, is received through the Internet, and collected through the Internet. Further, Claim 30 states that an analysis of the opinion information is used to draft an improved design of the trial

² See page 6 of the outstanding Office Action.

product, and that the customers are notified of information on the improved design. Thus, the method of Claim 30 clearly uses the opinion information entered by the users in a functional manner, i.e., to inform the customers of information on an improved design of the trial product according to the analysis of the opinion information.

Further, the display of the preview design of an image of the trial product is functionally related to the inputting step since it is the basis of the opinion information input by the customers. Accordingly, Applicant respectfully submits that the displayed information regarding a trial product is functional descriptive material since it is required for the customers to form an opinion, and is thus functionally involved in the steps recited in Claim 30.

Further, Applicant notes that the limitation within the displaying step stating that the display of the inquiry input screen is prior to manufacture of the trial product of the new merchandise is a limitation as to **when** the inquiry input screen is displayed, not on the type of information that is displayed. Accordingly, Applicant respectfully submits that this limitation is a functional limitation (indicating when a step occurs) and must be given weight and that, as discussed below, the '908 patent does not disclose the inputting of opinion information prior to the manufacture of the trial product of the new merchandise.

The '908 patent is directed to a customer-based product design module configured to interact with customers, gather information from customers, communicate customer information securely to a vendor or an external third party, construct and transmit new preprogrammed interactions to the customer communication system in a product, and analyze and report customer information. In particular, as shown in Figure 2, the '908 patent discloses a system in which the users of a product may provide feedback information to the product designers while the users are using the product. In particular, the '908 patent

discloses a customer-based product design module (CB-PD module) that may be attached to a device or incorporated into a device, such as a fax machine.

The '908 patent discloses that the CB-PD module can be used to accelerate future improvements in the product by means of customer generated suggestions and insights.³ In this regard, Applicant notes that Figures 24 and 25, and column 32, lines 51-67 relate to the user providing feedback to the developer based on the user's use of the product. Moreover, Applicant notes that the Office Action has cited to column 48, lines 32-42 and column 77, lines 10-15 as disclosing that "the system accepts customer feedback regarding information and improvements on products before new merchandise is used."⁴

However, Applicant notes that the '908 patent repeatedly states that the entire purpose of the '908 patent is to provide feedback on the use of products while the products are being used. For example, the '908 patent states that

[t]he customer design system (CDS) in Figure 1 gives vendors hands-on customer-based information 30 that is generated WHILE THEIR PRODUCTS ARE BEING USED. At their moments of greatest need, customers tell vendors their perceptions, expectations and the short-comings of their products and their associated services 24. They are able to communicate 24, 'this is what I'm doing to use your product. This is why I need it and why I use it this way. Here are the specific things I'd like you to improve, and why they are important to me. I'd also like to tell you how to improve your relationship with me. Here are the important things I'd like you to do now.'⁵

Further, the Summary of the Invention of the '908 patent states that "this customer-based product design module (CB-PD module) invention is designed to embed a new type of product feature within a range of products and services, helping them evolve into customer directed products (CDP) by means of development interactions (D1). The result is a

³ See '908 patent, column 12, lines 43-46.

⁴ See page 4 of the outstanding Office Action.

⁵ '908 Patent, col. 18, lines 21-32. Emphasis in original.

continuous source of aggregate customer desires (ACD) and define customer desires (CDC) from customers and users while they are using these products and services.⁶

Further, the Abstract of the '908 patent describes embedding the invention in products or services and discusses obtaining feedback while the products are being used.

Additionally, Applicant notes that as disclosed in column 16, lines 4-60, the '908 patent discloses that an interactive product can include the CB-PD module that may be attached to a product or built into it, and that customer probes including prompts or questions are stored in the CB-PD module for interacting with the customer. Further, the '908 patent discloses that the "aggregate customer desires" are the raw data that results from the customer use of the CB-PD module. Again, as disclosed in column 18, lines 20-24, the system shown in '908 Figure 1 gives vendors hands-on customer information that is generated while the products are being used.

Further, the passage in column 77, lines 10-15 of the '908 patent relates to field testing of prototypes before the product is shipped. However, Applicant notes that field testing still involves use of a product, while Claim 30 requires opinion information to be inputted on the merchandise planning and development information and not on use of the new merchandise. Accordingly, Applicant respectfully submits that the passage in column 77 does not read on the input of information prior to the use of merchandise, since field testing is the use of merchandise.

Further, Applicant notes that the cited section in column 48 of the '908 patent relates to ways that a user directs the design evolution of the products, but that all the feedback provided by the user relates to the use of a particular product. In particular, the '908 patent discloses in column 48 that the CB-PD module could be programmed to include "what if opportunities for simulations in using the products in certain ways, which again is

⁶ '908 Patent, col. 9, lines 18-26. Emphasis added.

information regarding how an existing product may be used in different ways, but is not based on merchandise planning and development information prior to manufacture or use of new merchandise.

However, Applicant respectfully submits that the ‘908 patent fails to a merchandise planning information notice step that informs many and unspecified customers of merchandise planning and development information relating to design specifications of a trial product of new merchandise and until before the trial product of the new merchandise is manufactured, as recited in amended Claim 30.

Further, Applicant respectfully submits that the ‘908 patent fails to disclose displaying, on a display of a customer client, the merchandise planning and development information including a preview design of an image of the trial product, as recited in amended Claim 30.

Further, Applicant respectfully submits that the ‘908 patent fails to disclose an inputting step of displaying an inquiry input screen on the display of the customer client after displaying the preview design of the image of the trial product for enabling the customers to input opinion information based on the displayed merchandise planning and development information in the development period of the new merchandise, prior to manufacture of the trial product of the new merchandise, not on actual use of the new merchandise by the customers, but on the merchandise planning and development information displayed on the display of the customer client, as recited in amended Claim 30.

Further, it must also follow that the ‘908 patent fails to disclose a drafting step of drafting an improved design of the trial product of the new merchandise using a computer-aided design device, based on an improved design and specification of the trial product of the new merchandise determined according to an analysis of the opinion information collected, as recited in amended Claim 30.

The '051 patent is directed to a system configured to process information to identify product choices within a range of product choices for a user, based on user preferences. Thus, the '051 patent discloses a system that attempts to identify appropriate product choices for a user from a predetermined list of existing products.

However, Applicant respectfully submits that the '051 patent fails to remedy the deficiencies of the '908 patent, as discussed above. In particular, Applicant respectfully submits that the '051 patent fails to disclose the merchandise planning information notice step of informing many and unspecified customers of merchandise planning and development information relating to design specifications of a trial product of new merchandise in a development period, through the Internet, and until before the trial product of the new merchandise is manufactured, as recited in amended Claim 30.

Further, Applicant respectfully submits that the '051 patent fails to disclose the displaying and inputting steps recited in amended Claim 30.

Further, Applicant respectfully submits that the '051 patent fails to disclose a drafting step of drafting an improved design of the trial product of the new merchandise using a computer-aided design (CAD) device, based on an improved design and specification of the trial product of the new merchandise determined according to an analysis of the opinion information collected, as recited in amended Claim 30.

Thus, no matter how the teachings of the '908 and '051 patents are combined, the combination does not teach or suggest a merchandise planning and development method including the merchandise planning information notice step, the displaying step, the inputting step, and the drafting step recited in amended Claim 30. Accordingly, Applicant respectfully submits that the rejection of Claim 30 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 30, and that Claim 30 patentably defines over any proper combination of the '908 and '051 patents.

Independent Claim 55 recites limitations analogous to the limitations recited in amended Claim 30. Moreover, Claim 55 has been amended in a manner analogous to the amendment to Claim 30. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 30, Applicant respectfully submits that the rejection of Claim 55 is rendered moot by the present amendment to that claim.

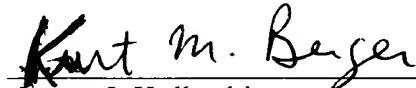
Regarding the rejection of dependent Claims 34-54 under 35 U.S.C. § 103(a), Applicant respectfully submits that the ‘014 patent, the ‘051 patent, and the Palmer and Anonymous references fail to remedy the deficiencies of the ‘908 and ‘051 patents, as discussed above. Accordingly, Applicant respectfully submits that the rejections of dependent Claims 34-54 are rendered moot by the present amendment to independent Claim 30.

Thus, it is respectfully submitted that independent Claims 30 and 55 (and all associated dependent claims) patentably define over any proper combination of the cited references.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


James J. Kulbaski

James J. Kulbaski
Attorney of Record
Registration No. 34.648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

Kurt M. Berger, Ph.D.
Registration No. 51,461